



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/048,045 | 01/24/2002 | Menno Hazenkamp | HF/5-22053/A/PCT | 2753 |

324 7590 07/18/2003

CIBA SPECIALTY CHEMICALS CORPORATION
PATENT DEPARTMENT
540 WHITE PLAINS RD
P O BOX 2005
TARRYTOWN, NY 10591-9005

EXAMINER

DELCOTTO, GREGORY R

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

1751

6

DATE MAILED: 07/18/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

| | | |
|----------------------------------|----------------------------------|--|
| Application No. 10/048,045 | Applicant(s) HAZENKAMP ET AL. | |
| Examiner Gregory R. Del Cotto | Art Unit 1751 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 January 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 16-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 16-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 16-30 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>5</u> . | 6) <input type="checkbox"/> Other: |

DETAILED ACTION

1. Claims 16-30 are pending. Claims 1-15 have been canceled. The preliminary amendment filed 1/24/02 has been entered.

Priority

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Election/Restrictions

This application contains claims directed to more than one species of the generic invention. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.

The species are as follows:

1. Embodiments wherein the manganese complex is a compound of Formula (1).
2. Embodiments wherein the manganese complex is a compound of Formula (2).
3. Embodiments wherein the manganese complex is a compound of Formula (3).

Applicant is required, in reply to this action, to elect a single species to which the claims shall be restricted if no generic claim is finally held to be allowable. The reply must also identify the claims readable on the elected species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

The claims are deemed to correspond to the species listed above in the following manner:

1. Claims 16-30
2. Claims 16-30
3. Claims 16-20 and 22-30.

The following claim(s) are generic: None.

The species listed above do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, the species lack the same or corresponding special technical features for the following reasons: Pursuant to PCT Rule 13.2 and PCT Administrative Instructions, Annex B, Part 1(f)(1)(B)(2), the species are not art recognized equivalents.

During a telephone conversation with Kevin Mansfield on July 10, 2003, a provisional election was made with traverse to prosecute the invention of manganese complexes corresponding to Formula (1), claims 16-30. Affirmation of this election must be made by applicant in replying to this Office action. No claims are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim

Art Unit: 1751

remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 16-30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With respect to claim 16, this claim is vague and indefinite in that it is unclear what is meant by "salen-type" manganese complexes and what compounds or complexes would be encompassed by this terminology. The addition of the word "type" to an otherwise definite expression extends the scope of the expression so as to render it indefinite. Ex parte Copenhaver, 109 USPQ 118 (Bd. App. 1955). See MPEP 2173.05c). Note that, the specification provides no guidance or definition as to what is meant by "salen-type".

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Art Unit: 1751

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 16-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 630,964, EP 902,083, or Bacher et al (US 5,965,506).

'964 teach a process for inhibiting the reabsorption of migrating dyes in the wash liquor comprising introducing into a wash liquor containing a peroxide-containing detergent, from 0.5 to 150, preferably from 1.5 to 75 mg per liter of wash liquor, of a manganese compound which encompasses manganese compounds having the same formula as formula (1) as recited by the instant claims. See Abstract. '964 also teach a detergent composition containing 5 to 90% of anionic surfactant and/or nonionic surfactant, 5 to 70% of a builder, 0.1 to 30% of a peroxide and 0.005 to 2% by weight of a manganese compound. The detergent may be formulaed as a solid; preferably, the detergent is in powder or granulate form. See page 3, lines 20-65. The nonionic surfactant may be a condensate of ethylene oxide with a C9-C15 primary alcohol having 3 to 8 moles of ethylene oxide per mole. A particularly preferred detergent co-additive

is a polymer known to be useful in preventing the transfer of labile dyes between fabrics such as polyvinyl pyrrolidones. See page 5, lines 40-60

Bacher et al teach a fabric bleaching composition comprising a peroxy compound and a specified and a specified manganese complex. See Abstract. Note that, Bacher teaches the same manganese complexes as recited by formula (1) of the instant claims. See column 3, line 1 to column 8, line 69. Additionally, the bleaching compositions also comprise a surfactant and a detergent builder. The anionic surfactant may be a sulphate, a sulphonate, or carboxylate. The nonionic surfactant may be a condensate of ethylene oxide with a C9-C15 primary alcohol having 3 to 8 moles of ethylene oxide per mole. A particularly preferred detergent co-additive is a polymer known to be useful in preventing the transfer of labile dyes between fabrics such as polyvinyl pyrrolidones. The fabric bleaching composition may be formulated as a solid, preferably in powder or granulate form. See column 11, lines 30-60.

'083 teaches a process for inhibiting the reabsorption of migrating dyes in the wash liquor comprising introducing into a wash liquor containing a peroxide-containing detergent, from 0.5 to 150, preferably from 1.5 to 75 mg per liter of wash liquor, of a manganese compound which encompasses manganese compounds having the same formula as formula (1) as recited by the instant claims. See Abstract. '083 also teach a detergent composition containing 5 to 90% of anionic surfactant and/or nonionic surfactant, 5 to 70% of a builder, 0.1 to 30% of a peroxide and 0.005 to 2% by weight of a manganese compound. The detergent may be formulated as a solid; preferably, the detergent is in powder or granulate form. See page 6, lines 15-50. The nonionic

Art Unit: 1751

surfactant may be a condensate of ethylene oxide with a C9-C15 primary alcohol having 3 to 8 moles of ethylene oxide per mole. See column 6, lines 45-65. A particularly preferred detergent co-additive is a polymer known to be useful in preventing the transfer of labile dyes between fabrics such as polyvinyl pyrrolidones. See column 7, lines 30-60.

Note that, all three references teach examples in which the granules exemplified contain water. Additionally, the Examiner asserts that the powders or granules as taught by '964, Bacher et al, or EP 902,083 would encompass the granules as taught by claim 16 or 30. Note that, both claims recite "comprising" which would allow the inclusion of all other ingredients.

'964, Bacher et al, or EP 902,083 do not specifically teach a granule containing a water-soluble salen-type manganese complex, a dissolution restrainer and composition containing said granules along with surfactant, builder, peroxide and the other requisite components of the composition in the specific proportions as recited by the instant claims.

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to formulate a granule containing a water-soluble manganese complex, a dissolution restrainer and composition containing said granules along with surfactant, builder, peroxide and the other requisite components of the composition in the specific proportions as recited by the instant claims, with a reasonable expectation of success and similar results with respect to other disclosed components, because the broad teachings of '964, Bacher et al, or EP 902,083 suggest a granule containing a

Art Unit: 1751

water-soluble manganese complex, a dissolution restrainer and composition containing said granules along with surfactant, builder, peroxide and the other requisite components of the composition in the specific proportions as recited by the instant claims.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Remaining references cited but not relied upon are considered to be cumulative to or less pertinent than those relied upon or discussed above.

Applicant is reminded that any evidence to be presented in accordance with 37 CAR 1.131 or 1.132 should be submitted before final rejection in order to be considered timely.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory R. Del Cotto whose telephone number is (703) 308-2519. The examiner can normally be reached on Mon. thru Fri. from 8:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yogendra Gupta can be reached on (703) 308-4708. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Art Unit: 1751

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



Gregory R. Del Cotto
Primary Examiner
Art Unit 1751

GRD
July 14, 2003